



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Applicants: Bednorz et al.

Serial No.: 08/479,810

Filed: June 7, 1995

For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION
TEMPERATURE, METHODS FOR THEIR USE AND PREPARATION

Date: January 28, 2005

Docket: YO987-074BZ

Group Art Unit: 1751

Examiner: M. Kopec

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR 1.181 or 1.182

Sir:

The Office Action dated July 28, 2004, does not respond to all the arguments and evidence presented by the Applicants in rebuttal of the Examiner's rejection of Applicants' claims under 35 USC 112, first paragraph, for lack of enablement. If the Examiner does not allow all of Applicants' claims in response to Applicants' Amendment submitted January 28, 2005, Applicants' petition for a non-final office action providing the Examiner's reasons for why all of Applicants' arguments and evidence (in particular the arguments and evidence to which the Examiner did not respond in the in the Office Action of July 28, 2004) do not place Applicants' application in condition for allowance.

DETAILED REASONS FOR PETITION

The Office Action dated July 28, 2004 does not respond to all of Applicants' arguments and factual data as to why all of Applicants' claims are fully enabled. Prior to final rejection Applicants are entitled to the Examiner's reasons why Applicants' arguments and factual evidence in support of Applicants' position of enablement are not found persuasive by the Examiner. A final rejection is improper without the Examiner's comments. To finally reject Applicants' claims without the missing Examiner's comments means that Applicants for the first time will, if at all, know of the Examiner's missing reasons either in a final rejection, the Examiner's Answer to Applicants' Brief on Appeal or in a Decision by the Board of Appeals. This will substantially disadvantage Applicants since after final rejection, Applicants have limited ability (or none at all) to introduce new arguments and evidence to rebut the reason for why Applicants unresponded to arguments and evidence do not overcome the rejections for lack of enablement.

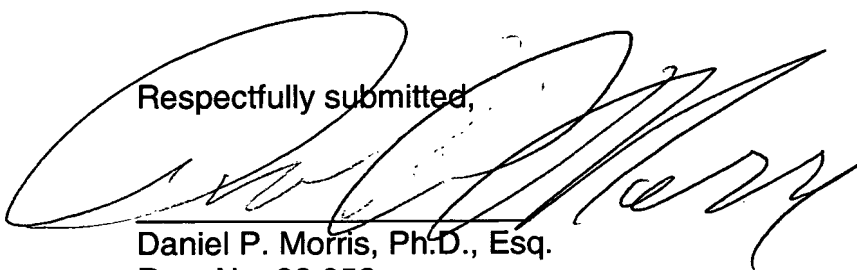
The Examiner did not respond to Applicants' arguments and evidence in support of full enablement of all the claims as specifically indicated in the following list:

1. The article by Rao "Synthesis of Cuprate Superconductors" referred to in the Fifth Supplemental Amendment dated March 1, 2004, at page 119, lines 7-17; page 143, line 17 to page 150, line 17; and page 174, line 14 to page 176, line 4 from the bottom.

2. The Handbook of Chemistry and Physics Table of High Tc Superconductors referred to at page 176, line 3 from the bottom to page 178, last line of the Fifth Supplementary Amendment dated March 1, 2004.
3. Applicants' Remarks on the ancestral file history pages 179 to 183 of the Fifth Supplementary Amendment dated March 1, 2004.
4. Applicants' remarks on why Rejections under 35 USC 102 and 103 over the Asahi Shinbum article necessarily lead to the conclusion that all of Applicants' claims are enabled referred to on page 23 to page 25 of the Fifth Supplementary Amendment dated March 1, 2004.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,



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